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separate and distinct at numerous passages: "The aforementioned objects are carried out by a portable radio telephone handset of the present invention, including means for communicating in an analog cellular mode, means for communicating in a Cellular Digital Packet Data (CDPD) mode *and means for selecting between the two modes*" (column 4 lines 13-18); "*discriminating between* information in the paging signal *pertaining to CDPD* transmission and information *pertaining to analog cellular mode* transmission" (column 4 lines 24-27); "a radio frequency transceiver *switchably* operable in *either an analog cellular mode or a Cellular Data Pack[sic] Data (CDPD) mode* and processor means for controlling operation in both the analog cellular mode and the CDPD mode" (column 4 lines 29-35).

Jennings discloses a communication system which includes a voice subsystem and a multimedia subsystem. Jennings discloses that in VOIP applications: "voice signals are digitized and packetized at a sending location, transmitted via the Internet in a digital format to a receiving location where they are converted into analog voice signals and played to a called party" (column 2 lines 2-5). Jennings mentions that a VOIP phone may be used within the communication system and states that: "For example, should the end point device 110 be a multimedia enabled Voice Over Internet Protocol (VOIP) phone serviced by a computer, the communication link 112 comprises simply an Internet connection." Jennings depicts in Figure 2A a communications system 202 which may be coupled to a wireless network 224.

To establish a *prima facie* case of obviousness, three basic criteria must be met, one of which is that there must be some suggestion or motivation to modify the references or combine reference teachings.

The Examiner has stated that "it would have been obvious to use VOIP communication of Jennings *et al.* in the radio telephone handset of Lubin *et al.* in order to packetize the raw data signal into the VOIP packet at the sending location and depacketize the VOIP packet into voice stream at the receiving location". The Examiner has put forth a factual assertion that "to transmit voice over data via IP network which is free for users while it costs more to make long distance calls between users via PSTN", as the motivation to combine Lubin and Jennings to obtain the method of independent claim 19.

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Claim 19 is directed to a method of digital cellular communications comprising the steps of receiving radio signals from a digital cellular network, converting the radio signals into raw data signals, processing the raw data signals into a voice over Internet Protocol packetized data stream, unpacketizing the voice over Internet Protocol packetized data stream into a voice data stream, converting the voice data stream into analog waveforms, and broadcasting the analog waveforms.

Applicant respectfully submits that the Examiner has not shown that there is any suggestion or motivation to modify the references or combine the reference teachings, and submits, moreover, that the factual assertion made by the Examiner does not lead to a motivation to combine the references, nor to combine said references to obtain the method of claim 19, and hence that the requirements for a case of *prima facie* obviousness have not all been met. Furthermore, Applicant submits that the Examiner has not provided any support, reference, authority, or objective evidence, for the factual assertion upon which the alleged motivation is based. Finally, Applicant submits that irrespective of the Examiner's alleging a motivation to combine which is unsupported and does not lead to the method of claim 19 or the combination of references, no suggestion or motivation to modify the references or combine the reference teachings to obtain the method of claim 19 is to be found in the references cited.

Alleged Motivation Does Not Lead to Obtaining Method
Claim 19 Nor the Combination of Lubin and Jennings

Applicant submits that if the factual assertion put forth by the Examiner as the basis for the alleged motivation, namely, "voice over data via IP network which is free to the users while it costs more to make long distance calls between users via PSTN" were true, it would in fact serve as a motivation to arrive at a system which is not that which is claimed in claim 19.

Figure 2A of Jennings depicts a VOIP phone 209 coupled to an IP network 212 (which may include the Internet) which is coupled to a communications system 202 which is in turn coupled to a wireless network 224 which may communicate with a mobile station 220 through a base station 221.

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As described hereinabove, the cellular handset of Lubin is capable of communicating in either voice mode or data mode. If a person skilled in the art were to combine Lubin and Jennings in response to the factual assertion made by the Examiner, that person skilled in the art would be motivated, as Applicant submits, to simply use the voice mode capability of the cellular handset of Lubin to communicate with the wireless network 224 of Jennings which would communicate with the communication system 202. The communication system would perform VOIP communication over the IP network 212 with the VOIP phone which otherwise would be subject to long distance charges at a remote location. Alternatively, the person skilled in the art would arrange for a second communication system 202 at the remote location which would convert VOIP into regular voice over wireless communication to communicate with a second wireless network 224 which could communicate with a second cellular handset of Lubin operating in voice mode.

Given the factual assertion made by the Examiner, and Figure 2A of Jennings, if a person skilled in the art were to combine Lubin and Jennings, this is the manner in which he or she would combine Lubin and Jennings to avoid long distance charges of the PSTN network, and to take advantage of a "free" Internet (if that were the case). Since the factual assertion made by the Examiner does not address in any way the cost of VOIP in a digital cellular communications system as compared to long distance over PSTN, a person skilled in the art would not be motivated to combine Lubin and Jennings beyond that described above. Hence, since claim 19 would not be obtained, the factual assertion is not a motivation to combine the references to arrive at claim 19.

Applicant submits that in view of the disclosures of Lubin and Jennings, the factual assertion would not motivate one to modify Lubin with the VOIP of Jennings. Even if the Internet were "free", and long distance charges via landbased PSTN were more costly, it does not necessarily or simply follow that the cellular handset and system of Lubin, if modified to include VOIP transmission, would be "free" to use when the voice data packets are transmitted in data mode or that long distance charges via PSTN would necessarily be more costly than the cost associated with the infrastructure, maintenance, and use of bandwidth associated with a cellular VOIP system from a modification of Lubin with the VOIP of Jennings. It is not at all obvious

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that given the factual assertion made by the Examiner, Lubin and the VOIP of Jennings would or should be combined in the manner alleged by the Examiner, hence the factual assertion does not serve as a motivation to combine Lubin and the VOIP of Jennings.

Applicant moreover submits that the factual assertion does not even provide a motivation to combine Lubin and Jennings. Lubin does not disclose anything about "long distance" carriers or charges, whereas Jennings refers to long distance charges at column 1 line 66 to column 2 line 1 "voice over Internet protocol (VOIP) applications serve to provide phone-like voice service over the Internet without PSTN long distance charges". At most Jennings may disclose that VOIP *per se* may be used to avoid the cost of standard PSTN long distance service, however, Jennings discloses nothing about cellular handsets having a data mode or VOIP in digital cellular networks and nothing about VOIP in a digital cellular network being less costly than long distance communication over a PSTN. Lubin discloses nothing about long distance charges or VOIP, while Jennings discloses nothing about cellular handsets having a data mode. The Examiner's basis for a motivation to combine simply does not make any statement with respect to digital cellular networks and charges associated with the transfer of data thereover. Applicant submits that the alleged motivation does not lead to or facilitate combination of Lubin and Jennings to obtain claim 19.

No Support for Alleged Motivation

Applicant submits that the Examiner has not cited any support for the factual veracity of the alleged motivation, and in particular the factual assertion that "transmitting voice over data via an IP network is free" and that "it costs more to make long distance calls between users via PSTN". Applicant submits that Lubin discloses nothing which suggests transmitting voice over data via an IP network is "free", and nothing regarding long distance calls. Moreover, Jennings at most discloses that long distance charges over PSTN may be avoided by use of VOIP over the Internet, but nothing about transmitting voice over data via an IP network is actually "free". Additionally, Jennings does not disclose that transmitting voice over data via an IP network is less costly than voice over PSTN, only that long distance charges are avoided.

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Since the references cited to not provide support for the factual assertions made in what the Examiner has alleged is the motivation to combine, it appears as though the Examiner is asserting it is common knowledge that transmission of "voice over data via IP network...is free" and "it costs more to make long distance calls between users via PSTN".

Applicant submits that the assertion that "voice over data via IP network ...is free" is not an obvious or self-evident fact which is known to persons skilled in the art, and in fact, Applicant respectfully submits it is not true. Any system which transmits and receives VOIP packets in a VOIP capable network will incur equipment, software, maintenance, and other costs in order to provide a service comparable to PSTN voice telephone. These costs are inevitably passed to the customer. Internet services are usually billed to the customers on a monthly basis with bit rate or online time caps, or extra charges when more than a set bandwidth per month is used. Applicant submits that an assertion which is unsupported and, as Applicant submits, simply not true, cannot form the basis of a motivation to combine references.

Any further assertion (which the Examiner heretofore has not made) that the VOIP of Jennings is less costly in a digital cellular setting of Lubin than standard long distance charges via PSTN is also not self-evident as many issues surrounding how cellular users of Lubin are charged for transferring data are not explained or disclosed in Lubin in comparison with how they are charged when making standard long distance calls. It is quite possible, that in a data and voice mode capable system of Lubin, VOIP over the data channels of Lubin would be more costly than standard long distance cellular communications. Applicant respectfully submits that an unsupported assertion which is factually untrue cannot form the basis of a motivation to combine.

No Motivation to Combine the References to
Obtain Claim 19 Found in the References

As discussed hereinabove, Lubin discloses nothing about "long distance charges" or VOIP, and Jennings discloses nothing about VOIP in the context of a cellular telecommunication system. Certainly neither Lubin nor Jennings suggests that VOIP in a cellular system is an effective, possible or even less costly approach than standard long distance cellular service. Both

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Lubin and Jennings identify that generally, prior art voice communication systems were well adapted for voice but not well suited for data, and data communication systems were well adapted for data, but ill-equipped to handle voice.

Lubin teaches a data mode and a voice mode. Applicant submits that there is no motivation in Lubin or Jennings to modify the method of cellular communication of Lubin which is already capable of voice communication over its analog mode, to be capable of performing VOIP communication over its data mode.

Applicant submits that prior to the present application no systems existed that marry the flexibility of digital cellular communications systems with the cost savings of Internet telephony. Applicant also submits that prior to the present application, call set-up, initiation and establishment for digital cellular handsets was particularly difficult to accomplish in the Internet domain. Applicant also submits that the present application has identified needs which the Examiner has not shown to be disclosed or identified prior to the present application, namely, a need to provide a system for providing a digital cellular handset that is enabled for Internet telephony, and a need to provide a means for setting-up, initiating, and establishing a digital cellular telephone call over the Internet.

For at least the reasons given above, Applicant submits that there is no motivation to combine Jennings and Lubin, moreover that said combination does not lead to obtaining method claim 19.

In view of at least the forgoing, Applicant submits that the Examiner has not shown a *prima facie* case of obviousness against independent claim 19 and respectfully requests that the Examiner withdraw the 35 U.S.C. 103(a) rejections of claim 19 and claims 20 and 21 which depend therefrom.

35 U.S.C. 102(e) Rejections

The Examiner has rejected claims 22, 25, 26, and 27 under 35 U.S.C. 102(e) as being anticipated by Ray *et al.* (U.S. Patent No. 6,067,529).

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Ray discloses a system and method for providing an electronic receipt to a consumer after making a purchase. The sales terminal is attached to a short message/e-mail sending capable terminal, and generates and routes a short message along with the detailed purchase information to an address associated with the consumer via a gate keeper for the Internet for the area in which the sales terminal is located.

Applicant respectfully traverses the Examiner's objection, and submits that Ray *et al.* does not disclose the method independent of claim 22. Applicant submits that Ray discloses a very different method from that claimed in claim 22, and simply does not disclose all of the method steps of claim 22.

Claim 22 is for a "method of initiating digital cellular communications over the Internet", and specifically recites generating an SMS message with the Internet Protocol (IP) address of a first Internet protocol enabled device embedded therein, forwarding said SMS message to the second Internet protocol enabled device, extracting the IP address from said SMS message, and using the IP address to connect a second Internet protocol enabled device to the first Internet protocol enabled device over the Internet. Claim 27 is for a "method of initiating digital cellular communications over the Internet", and specifically recites receiving an SMS message with an Internet Protocol (IP) address embedded therein, extracting the IP address from the SMS message, and using the IP address to connect to an Internet protocol enabled device.

Applicant submits that Ray does not disclose generating an SMS message with the Internet protocol IP address of a first Internet protocol enabled device embedded therein, and the forwarding of the SMS message to a second Internet protocol enabled device. The Examiner has identified the sale terminal 200 of Ray with the first Internet protocol enabled device, and the consumer 260 of Ray with the second Internet protocol enabled device. The Examiner has stated that in Ray "the sale terminal generates a short message 220 containing detail purchase information of the consumer and sends it to the consumer via an Internet 250" and has identified this with "generating a short message and forwarding the SMS message to the second Internet device", with reference to column 4, lines 15-20 and lines 30-35 of Ray.

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Applicant submits that the Examiner has not shown or even stated that Ray discloses "generating an SMS message with the Internet Protocol (IP) address of the first Internet protocol enabled device embedded therein". The sales terminal generates short message 220 containing detail purchase information. Nowhere in Ray is it disclosed that the short message 220 generated and sent by the sales terminal is embedded with an IP address of the sales terminal. In fact, Ray discloses a separate transport address 235, alias address 230, or IP address 238. At column 4 lines 20-24, Ray discloses "the short message can be sent towards the consumer's transport or alias address 230 by routing the short message 220 along with the transport or alias address 230 to a Gatekeeper 240 for the Internet 250 for the area 205 that the sale terminal 200 is located in."

Ray discloses at column 4 lines 53-58 that "originating Gatekeeper 240 can determine the correct remote Gatekeeper 270 for the area 275 that the telephone number 230 is associated with, convert the telephone number 230 into an IP address 238, and route the short message 220 containing the detailed receipt along with the IP address 238 through the Internet 250".

Whenever a short message is associated with an alias address, transport address, or IP address (ADD, TPADD, IPADD respectively), the figures show an SM 220 being routed along with a separate alias address, transport address, or IP address. Hence, consistent with the description of Ray, the figures show that the associated address is forwarded along with the short message, and is not embedded therein. Moreover, the address associated with the short message 220 is the address of the consumer's destination terminal 260, identified by the Examiner as the second Internet protocol enabled device. The address of Ray sent along with the short message is not the IP address of the first Internet protocol enabled device from which it is sent, but is instead the address of the second IP enabled device which is the destination device.

Applicant submits that Ray simply does not disclose "generating an SMS message with the Internet protocol (IP) address of the first Internet protocol enabled device embedded therein", and "forwarding said SMS message to the second Internet protocol enabled device".

Applicant further submits that Ray does not disclose "extracting the IP address from said SMS message". The Examiner has stated that Ray discloses "the consumer 260 receives the short message, and prints out a hard copy of short message 220 to get a refund when necessary". The Examiner has equated this with "second Internet device extracts IP address from the short

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message to connect to the first Internet device” and relies on column 5 lines 40-45 of Ray.

At column 5 lines 40 to 44, Ray discloses “in addition, by downloading the short message 220 to an IP terminal 260, the consumer can print out hard copies of the short message 220 containing detailed purchase information, which can be beneficial when attempting to obtain a refund”. Applicant submits that the passage relied upon by the Examiner discloses nothing about an IP address of a first Internet protocol enabled device embedded in a short message being extracted from the short message. Moreover, Applicant submits that nowhere in Ray is a method step of “extracting the IP address from said SMS message” disclosed.

Furthermore, Applicant submits that Ray does not disclose “using the IP address to connect the second Internet protocol enabled device to the first Internet protocol enabled device over the Internet”. As submitted hereinbefore, in Ray, the address of the destination terminal 260 is forwarded along with the short message for routing the short message from the sales terminal 200 to the destination terminal 260. As such, since in Ray the address associated with the short message forwarded along to the consumer terminal 260, is an address of the consumer terminal 260 itself, the address is not and could not then be used to connect the consumer terminal 260 to the sales terminal 200. Ray discloses an address to route the short message to the destination terminal 260, not an address of the sales terminal 200 embedded in the short message so that the destination terminal 260 can connect to the sales terminal 200.

For at least the foregoing reasons, Applicant submits that Ray does not disclose all of the features of independent claims 22 and 27 that therefore, Ray does not anticipate claims 22 or 27 nor claims 25 and 26 which depend therefrom. Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. 102(e) rejections of claims 22, 25, 26, and 27.

Claims Which are Objected to: Claims 23, 24, and 28

Applicant notes with appreciation Examiner’s indication on page 5 of the Office Action that claims 23, 24, and 28 are objected to. In the absence of any further reasons put forth by the Examiner specifically with respect to the recitations of dependent claims 23, 24, and 28, Applicant is of the understanding that claims 23, 24, and 28 are objected to solely upon the basis of the 35 U.S.C. 102(e) rejections of base claims 22 and 27. Applicant submits, in view of Ray’s

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failure to disclose all of the features of base claims 22 or 27, that Ray similarly does not disclose all of the features of claims 23, 24, or 28 which depend therefrom. Applicant therefore respectfully submits that claims 23, 24, or 28 are allowable in their present form, and respectfully requests that the Examiner withdraw the objections thereto.

Applicant believes that all of the Examiner's rejections have been traversed by the foregoing and respectfully requests that a timely Notice of Allowance be issued in this case.

If there are any outstanding issues, the Examiner is respectfully requested to telephone the undersigned.

Respectfully submitted,

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